

REMARKS

I. Status of Claims

Claims 65-69, 71-74, 76, and 78-147 are pending in this application. Claim 147 is newly added. Claims 70, 75, and 77 have been cancelled without prejudice or disclaimer. Claims 65-69, 72-74, 76-85, 87-88, 90-92, 95-98, 100, 102-107, 108-113, 115-121, 130-132, 134, 137-138, and 142-146 have been amended, and support for those amendments can be found at least either at pages 2-6 in the specification, or in the corresponding original claims. Claim 95 has been amended to comply with the Examiner's suggestion. Accordingly, there is written description support for all the claims, as amended.

II. Restriction Requirement

The Examiner made the Restriction Requirement of May 1, 2008, final. See Office Action at 2-4. The Examiner withdrew claims 137-146 "from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention". The Examiner argues that no special technical feature exists because the current claims are anticipated by U.S. Patent No. 6,153,206 to Anton et al. ("Anton"). Office Action at 3. Admitting that Anton does not disclose a resistive index as claimed herein, the Examiner attempts to rely on Anton for its alleged inherent teaching to conclude that Anton anticipates the claims. Applicants respectfully disagree for the following reasons.

"A claim is anticipated only if **each and every element as set forth in the claim** is found, either expressly or inherently described, in a single prior art reference."

M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,

631 (Fed. Cir. 1987))(emphasis added). Claim 65, as amended, for example, recites, *inter alia*, that "wherein the lip makeup composition has a resistive index of greater than or equal to 80%". Anton does not teach a resistive index, let alone the resistive index of greater or equal to 80% as claimed in the instant application.

Furthermore, Anton teaches a synthetic polymer comprising a first repeat unit and a second repeat unit, wherein the term "repeat unit" means a monomer unit of the polymer which is present more than one time in the polymer chain. See col. 2, lines 13-22, and col. 3, lines 21-24. Accordingly, that synthetic polymer is not described as in claim 65, as amended, as at least one styrene-free film-forming block ethylenic polymer comprising at least one first block and at least one second block that have different glass transition temperatures (T_g), wherein the at least one first block and the at least one second block are connected together via at least one intermediate block comprising at least one constituent monomer of the at least one first block and at least one constituent monomer of the at least one second block, wherein said at least one intermediate block is a random copolymer block.

Moreover, Anton describes various types of copolymers in the table in col. 4 wherein each of the listed repeat unit, when polymerized to form a homopolymer, has a glass transition temperature above 40 °C. Therefore not a single one of the copolymers meets the recitation of claim 65, as amended:.

"and the at least one first block is chosen from:

- a) a block with a T_g of greater than or equal to 40°C,
 - b) a block with a T_g of less than or equal to 20°C,
 - c) a block with a T_g from greater than 20 to less than 40°C,
- and the at least one second block is chosen from a category a), b) or c) different from the at least one first block "

In addition, not a single copolymer in the table in col. 4 falls within the claimed scope, in relevant part, as amended, wherein "the at least one first block and the at least one second block are connected together via at least one intermediate block comprising at least one constituent monomer of the at least one first block and at least one constituent monomer of the at least one second block, wherein said at least one intermediate block is a random copolymer block".

To the extent that Anton discloses the experimental procedures of how to make copolymer, see Example 1, col. 11, Anton simply discloses controlled polymerization. In contrast, to make the at least one styrene-free film-forming block ethylenic polymer recited in claim 65, as amended one needs to perform sequential polymerization as illustrated in Example 1 of the present application.

Hence, Anton does not anticipate claim 65, as amended, and the restriction requirement should be withdrawn.

Additionally, the Examiner withdrew claim 89 as allegedly being drawn to a non-elected species. Office Action at 4. That is moot since as pointed out above, the basis for the restriction requirement is improper and that requirement should be withdrawn. Furthermore, the Examiner appears to reach that conclusion, by relying on a finding that the block comprising isobornyl (meth)acrylate must have a T_g of greater than or equal to 40°C. Applicants note that the specification discloses isobornyl (meth)acrylate monomer can form one homopolymer block with a T_g of greater than or equal to 40°C. However, the specification also indicates a copolymer block comprising isobornyl (meth)acrylate monomer can have a T_g between 20°C-40°C. See line 20, page 17 and lines 17-18, page 21. Thus, claim 89 is drawn to an elected species. Applicants

respectfully request claim 89 be examined, whether or not the restriction requirement is withdrawn.

Furthermore, Applicants respectfully remind the Examiner of the rejoinder procedure of M.P.E.P. § 821.04. The M.P.E.P. requires that "[i]n order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim." *Id.* Applicants point out that the claims of Groups II-IV, which are directed to a cosmetic assembly comprising a lip makeup composition claimed in claims 65 or 66, a cosmetic process comprising applying a lip makeup composition as claimed in claims 65 or 66, and a method for making lip makeup composition as claimed in claims 65 or 66, respectively, comply with this provision. Therefore, these claims are eligible for rejoinder once the lip makeup composition of claims 65 and 66 are found patentable. Accordingly, Applicants respectfully request that all pending claims be examined in this application.

III. **Priority**

Applicants appreciate the Examiner's indication that the earliest effective U.S. filing date of the instant application has been determined to be September 26, 2003, the international filing date of the corresponding PCT Application No. PCT/FR03/02843.

IV. **Information Disclosure Statement**

Applicants note the Examiner states that he did not consider certain documents in the IDS. That is incorrect, and all of those documents should be marked as considered. .

V. **Claim Objections**

Claim 95 is objected for informalities - the word "and" instead of "an" should be used in the next to last line of the claim. Office Action at 5. Applicants have hereby corrected the informality, and respectfully request the withdrawal of this objection.

VI. Claim Rejections - 35 U.S.C. §112 (2nd Paragraph)

Claims 79-82, 84-85, 87-88, and 90-91 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Office Action at 5-6. Specifically, the Examiner indicates that it is not clear to one of ordinary skill in the art, what the percentage of the first block is relative to. Applicants greatly appreciate the Examiner's diligence in calling Applicants' attention to this issue and have amended the claims to moot that rejection. Accordingly, Applicants respectfully request the withdrawal of the rejection.

VII. Claim Rejections - 35 U.S.C. §102

Claims 65-69, 114-124, 126-128, and 130-136 are rejected under 35 U.S.C. §112(b) as allegedly being anticipated by U.S. Patent No. 6,153,206 to ANTON et al. ("Anton") for reasons set forth at pages 7-10 of the Office Action. Specifically, the Examiner contends that "it is reasonably that the transfer resistant lipstick compositions taught by Anton (e.g. Example 1) would be capable of having a resistive index greater than or equal to 80%, 85%, or 95% when present in a sufficient amount, which is all that is required by instant claims 65-68." Applicants respectfully disagree and traverse for at least the following reasons.

As the foregoing arguments demonstrate, Anton does not anticipate claim 65, as amended, claim 66, as amended, or any other pending claim.. As such, Applicants respectfully request the withdrawal of the anticipation rejections.

VIII. Claim Rejections - 35 U.S.C. §103

A. Over Anton in view of GALLEGUILLOS

Claims 65-74, 77-88, and 90-136 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Anton in view of GALLEGUILLOS (U.S. Patent No. 6,410,005) for reasons as set forth at pages 10-19 of the Office Action. Applicants respectfully disagree and traverse.

Anton does not teach, expressly or inherently, each and every element of the current claims as discussed above, and GALLEGUILLOS does not rectify Anton's deficiency. Solely to advance prosecution and without addressing the merits of the Examiner's position that -X-X- linkage reads on the instant intermediate block, Applicants respectfully submit the intermediate block as claimed, as amended, is a random copolymer, which clearly is distinguished from the linkage X-X. Therefore, Anton and GALLEGUILLOS, whether taken alone or in combination, do not render the current claims obvious. Accordingly, Applicants respectfully request the withdrawal of the obviousness rejection.

B. Over Anton in view of GALLEGUILLOS, and in further view of RAETHER

Claims 65-88 and 90-136 are rejected under under 35 U.S.C. §103(a) as allegedly being unpatentable over Anton in view of GALLEGUILLOS, and in further view

of RAETHER (U.S. Application No. 2004/0014872) for reasons as set forth at pages 19-20 of the Office Action.

First of all, RAETHER, a U.S. national stage application publication with a publication date as January 22, 2004, does not qualify as a prior art under any subsections of section 102. Assuming arguendo that the corresponding international application has exactly the same disclosure as RAETHER and constitutes a prior art under 103 (a), the international application does not rectify either Anton's or GALLEGUILLOS's deficiency, either. Those three references, whether taken alone or in combination, do not render the current claims obvious. As such, Applicants respectfully request the withdrawal of the obviousness rejection.

IX. Double Patenting

Claims 65-136 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims of 1-56 of copending Application No, 10/529,264, over claims 85-155 of copending Application No, 10/528,835, over claims of 77-163 of copending Application No, 10/529,266, and over claims of 80-165 of copending Application No, 10/529,218. Office Action at 21-25. Applicants presently agree with the double patenting rejection and presently plan to file an appropriate terminal disclaimer when allowable subject matter is indicated.

Conclusion


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Wen Li
Reg. No. 62,185
(202) 408-4000